



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,577	12/06/2001	Kenichi Asada	P/3236-36	4980

7590 07/14/2005
Steven I Weisburd Esq
Dickstein Shapiro Morin & Oshinsky LLP
1177 Avenue of the Americas 41st Floor
New York, NY 10036-2714

EXAMINER

RAMOS FELICIANO, ELISEO

ART UNIT	PAPER NUMBER
----------	--------------

2687

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/006,577

Applicant(s)

ASADA, KENICHI

Examiner

Eliseo Ramos-Feliciano

Art Unit

2687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10, 12 and 14 is/are rejected.
- 7) ☒ Claim(s) 5, 11 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Previous objection to claims 3, 7, 10-11 and 13 is withdrawn in view of Applicant's amendment filed April 4, 2005.

Claim Rejections - 35 USC § 112

2. Previous rejection to claims 8 and 10 under 35 USC 112, second paragraph, is withdrawn in view of Applicant's amendment filed April 4, 2005.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-4, 6, 8-10, 12 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda (US Patent Number 6,169,905) in view of Gillig et al. (US Patent Number 4,989,230).

Regarding **claim 1**, Fukuda discloses a notification system (Figure 4) for communicating (telephone call) between a sender phone (for example, remote station 4) and a receiver phone (for example, remote station 8) (telephone call between remote stations – column 5, line 28; and column 6, line 56) including:

a system configuration (Figures 4-5) for allowing said sender phone to transmit an ON state indication signal (control signal – Figure 5) indicating to switch ON a main power source (power supply) of said receiver phone through a radio wave (column 5, line 29) to said receiver

Art Unit: 2687

phone being in an OFF state (the remote station turns ON a power supply of its reception unit on the basis of a control signal – abstract, last three lines),

such that said main power source of said receiver phone is remotely turned ON (column 3, lines 58-60; column 4, lines 11-13; see column 6, lines 42-59).

However, even though Fukuda teaches that the remote station (sender phone or receiver phone) can be a digital cordless telephone (column 5, lines 5-7), Fukuda fails to specifically mention that the remote station is a cellular phone as claimed.

In the same field of endeavor, Gillig et al. discloses a notification system (Figure 1) that includes a cellular cordless telephone that may place/receive both cellular telephone calls and cordless telephone calls (column 1, lines 31-35; column 7, lines 64-68). In other words, Gillig et al. teaches a phone that can operate both cellular and cordless technology.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Fukuda's digital cordless telephones (remote stations: sender phone and receiver phone) to also be cellular telephones because this would enable to place or receive both cellular telephone calls and cordless telephone calls, as taught by Gillig et al., having the further advantage of expanded service area coverage.

Regarding **claim 2**, Fukuda and Gillig et al. disclose everything claimed as applied above (see *claim 1*). In addition, Fukuda discloses that after said receiver cellular phone becomes in said ON state, said receiver cellular phone is notified that a call is received (analog audio signal; the user can answer the incoming call – column 7, lines 1-25).

Regarding **claim 3**, Fukuda discloses a notification system (Figure 4) for communicating (telephone call) between a sender phone (for example, remote station 4) and a receiver phone

Art Unit: 2687

(for example, remote station 8) (telephone call between remote stations – column 6, line 56)

including:

a base station controlling device (“main master station 1” – column 5, line 55) for receiving receiver information (connection request control signal – column 1, line 30; column 6, line 45-47) “concerning” said receiver phone which main power source is in an OFF state (power supply of reception unit OFF), and for controlling at least one base station (“sub master stations 2 and 3” – column 5, lines 56-57) covering an area (inherent) indicated in said receiver information (column 5, lines 53-63); and

a base station (“sub master stations 2 and 3” – column 5, lines 56-57) for sending said receiver information, wherein:

said base station comprises a sub-system configuration for sending power-ON information (control signal – Figure 5) based on said receiver information received from said base station controlling device; and

said receiver phone comprises a device configuration for receiving said power-ON information from said base station even if said main power source is in said OFF state (the remote station turns ON a power supply of its reception unit on the basis of a control signal – abstract, last three lines) (see column 3, lines 58-60; column 4, lines 11-13; column 6, lines 42-59).

However, even though Fukuda teaches that the remote station (sender phone or receiver phone) can be a digital cordless telephone (column 5, lines 5-7), Fukuda fails to specifically mention that the remote station is a cellular phone as claimed.

Art Unit: 2687

In the same field of endeavor, Gillig et al. discloses a notification system (Figure 1) that includes a cellular cordless telephone that may place/receive both cellular telephone calls and cordless telephone calls (column 1, lines 31-35; column 7, lines 64-68). In other words, Gillig et al. teaches a phone that can operate both cellular and cordless technology.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Fukuda's digital cordless telephones (remote stations: sender phone and receiver phone) to also be cellular telephones because this would enable to place or receive both cellular telephone calls and cordless telephone calls, as taught by Gillig et al., having the further advantage of expanded service area coverage.

Regarding **claim 4**, Fukuda and Gillig et al. disclose everything claimed as applied above (see *claim 3*). In addition, Fukuda discloses that the receiver information includes at least one of a receiver cellular phone telephone number, a password to access said receiver cellular prone, and area information indicating an area where said receiver cellular phone is predicted to be. For example, identification No. of the target remote station (receiver cellular phone telephone number) (column 2, line 9).

Regarding **claim 6**, Fukuda discloses a method for communicating (telephone call) between a sender phone (for example, remote station 4) and a receiver phone (for example, remote station 8) (telephone call between remote stations – column 5, line 28; and column 6, line 56) including:

transmitting, by said sender phone, an ON state indication signal (control signal – Figure 5) indicating to switch ON a main power source (power supply) of said receiver phone through a radio wave (column 5, line 29) to said receiver phone being in an OFF state (the remote station

Art Unit: 2687

turns ON a power supply of its reception unit on the basis of a control signal – abstract, last three lines),

turning ON said main power source of said receiver phone in response to said ON state indication signal (column 3, lines 58-60; column 4, lines 11-13; see column 6, lines 42-59).

However, even though Fukuda teaches that the remote station (sender phone or receiver phone) can be a digital cordless telephone (column 5, lines 5-7), Fukuda fails to specifically mention that the remote station is a cellular phone as claimed.

In the same field of endeavor, Gillig et al. discloses a notification system (Figure 1) that includes a cellular cordless telephone that may place/receive both cellular telephone calls and cordless telephone calls (column 1, lines 31-35; column 7, lines 64-68). In other words, Gillig et al. teaches a phone that can operate both cellular and cordless technology.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Fukuda's digital cordless telephones (remote stations: sender phone and receiver phone) to also be cellular telephones because this would enable to place or receive both cellular telephone calls and cordless telephone calls, as taught by Gillig et al., having the further advantage of expanded service area coverage.

Regarding **claim 8**, Fukuda and Gillig et al. disclose everything claimed as applied above (see *claim 6*). In addition, Fukuda discloses that after said receiver cellular phone becomes in said ON state, said receiver cellular phone is notified that a call is received (analog audio signal; the user can answer the incoming call – column 7, lines 1-25).

Regarding **claim 9**, Fukuda discloses a phone (remote station 4 – Figure 4) comprising a device configuration for receiving a signal (control signal – Figure 5) for switching to be in an

Art Unit: 2687

ON state from a base station (master station – Figure 4; column 5, lines 53-63) and being capable of switching a main power source to be in said ON state even if said main power source is in an OFF state (the remote station turns ON a power supply of its reception unit on the basis of a control signal – abstract, last three lines; column 3, lines 58-60; column 4, lines 11-13; see also column 6, lines 42-59).

However, even though Fukuda teaches that the remote station (phone) can be a digital cordless telephone (column 5, lines 5-7), Fukuda fails to specifically mention that the remote station is a cellular phone as claimed.

In the same field of endeavor, Gillig et al. discloses a notification system (Figure 1) that includes a cellular cordless telephone that may place/receive both cellular telephone calls and cordless telephone calls (column 1, lines 31-35; column 7, lines 64-68). In other words, Gillig et al. teaches a phone that can operate both cellular and cordless technology.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Fukuda's digital cordless telephones (remote stations: sender phone and receiver phone) to also be cellular telephones because this would enable to place or receive both cellular telephone calls and cordless telephone calls, as taught by Gillig et al., having the further advantage of expanded service area coverage.

Regarding **claim 10**, Fukuda and Gillig et al. disclose everything claimed as applied above (see *claim 9*). In addition, Fukuda further discloses:

1) Establishing synchronization with at least said base station (via "sync word" in control signal – column 5, line 40) even if said main power source is in said OFF state (the remote station receives the control signal even when in standby mode which is an OFF state because the

Art Unit: 2687

power supply of its reception unit is OFF – column 6, lines 25-30; column 2, lines 10-12).

Therefore, a synchronization establishing circuit as claimed is inherent.

2) Extracting main power source ON information from a radio wave (column 5, line 29) transmitted from said base station (the remote station turns ON a power supply of its reception unit on the basis of a control signal – abstract, last three lines; column 3, lines 58-60; column 4, lines 11-13; see column 6, lines 42-59). Therefore, a main power source ON information detecting section as claimed is inherent.

3) A power source section (these limitations are inherent from above because the claimed circuit inherently needs power to operate) for supplying electric power to said main power source ON information detecting section and a location information detecting section to be kept in an ON-state, even if said main power source is in said OFF state, and for turning ON said main power source when said main power source ON information is input from said main power source ON information detecting section (abstract; column 3, lines 58-60; column 4, lines 11-13; and column 6, lines 42-59).

Regarding **claim 12**, Fukuda and Gillig et al. disclose everything claimed as applied above (see *claim 9*). As explained above Fukuda and Gillig et al. disclose the claimed cellular phone. The cellular phone “is used” as a receiver cellular phone in a notification system for communicating between a sender cellular phone and said receiver cellular phone. In addition, Fukuda further discloses wherein said notification system comprises:

a system configuration (Figures 4-5) for allowing said sender phone to transmit an ON state indication signal (control signal – Figure 5) indicating to switch ON a main power source (power supply) of said receiver phone through a radio wave (column 5, line 29) to said receiver

Art Unit: 2687

phone (the remote station turns ON a power supply of its reception unit on the basis of a control signal – abstract, last three lines),

such that said main power source of said receiver phone is remotely turned ON (column 3, lines 58-60; column 4, lines 11-13; see column 6, lines 42-59).

Regarding **claim 14**, Fukuda and Gillig et al. disclose everything claimed as applied above (see *claim 6*). In addition, Fukuda discloses that an OFF state status indication can be accessed from said receiver cellular phone (see the abstract, last three lines).

5. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda in view of Gillig et al. as applied to *claim 6* above, and further in view of MPEP 2144.03. Tsuchiyama (US Patent Number 5,847,657).

Regarding **claim 7**, Fukuda and Gillig et al. disclose everything claimed as applied above (see *claim 6*). However, they fail to specifically disclose confirming that the main power source of the receiver cellular phone to be notified is in the OFF state.

The examiner contends that such confirmation step is well known in the art and takes Official notice of such notion, because it is unnecessary to send a switch ON signal if the intended recipient is already ON. It is always desirable to remotely turn ON electronic devices that currently are in OFF state, not ON.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Fukuda and Gillig et al.'s invention to confirm that the receiver cellular phone is in the OFF state before remotely turning it ON, because it is unnecessary to transmit a switch ON signal if the intended recipient is already ON.

Allowable Subject Matter

Art Unit: 2687

6. **Claims 5, 11 and 13** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Reasons for the indication of allowable subject matter have been presented in previous Office action.

Response to Arguments

8. Applicant's arguments filed April 4, 2005 have been fully considered but they are not persuasive.

9. Applicant argues that not Fukuda nor Gillig teach transmitting an ON state indication signal, a signal to actually turn on a telephone (see, for example, page 8, last paragraph to page 9 of the response filed April 4, 2005). Applicant presents the aforementioned allegation throughout the full body of the remarks.

In response, it should be noted, as indicated in the rejection, that in numerous occasions Fukuda teaches that the remote station turns on a power supply of its reception unit on the basis of the control signal (ON state indication signal); see the abstract, last three lines; column 3, lines 58-60; and column 4, lines 11-13. This teaching is very clear for Fukuda. No doubt that the control signal is an "ON state indication signal" as claimed because it instructs Fakuda's remote station to turn on the power as claimed.

10. With respect to the argument just explained above, Applicant further argues that Fukuda teaches a different use of the control signal (see page 9, first full paragraph to the end of the page of the response filed April 4, 2005).

Art Unit: 2687

In response, Applicant's argument concerns an embodiment that was not applied, nor it is necessary for the discussion of the claims above. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.

11. With respect to the argument just explained above, Applicant further argues that Gillig does not cure the deficiencies of Fukuda (see page 10, second full paragraph of the response filed April 4, 2005).

In response, it should be noted that Gillig has not been applied to meet the argued limitation. The argued limitation is fully met by Fukuda as explained above. See the rejection above for a complete consideration.

12. In response to applicant's argument that Fukuda is a closed system (see page 10, last paragraph of the response filed April 4, 2005), the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

13. With respect to claims 2 and 7-8 & 3 and 9 Applicant repeats by incorporation by reference the same arguments presented against claims 1 and 6, discussed above (see page 11 of the response filed April 4, 2005).

In response, same explanation presented above is applied.

Conclusion

14. Applicant's amendment (e.g. newly added claim 14) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See

Art Unit: 2687


MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 571-272-7925. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid, can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ELISEO RAMOS-FELICIANO
PATENT EXAMINER

ERF/erf
July 7, 2005